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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/801,243

03/16/2004

Stephen Solomon

H-600

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41245

7590

10/20/2005

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EXAMINER

NEGRON, ISMAEL

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

*A E/L*

<b>Office Action Summary</b>	Application No.		Applicant(s)	
	10/801,243		SOLOMON, STEPHEN	
	Examiner		Art Unit	
	Ismael Negron		2875	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 6 and 9-21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/16/2004</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Title*

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Transparent Light-Emitting Signaling Apparatus Emergency Warning Light System for an Emergency Vehicle.

### *Abstract*

Applicant is reminded of the proper content and language of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;

- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because it fails to concisely state the subject matter of the invention, it exceeds 150 words in length, and it uses phrases which can be implied. Correction is required. See MPEP § 608.01(b).

The Examiner respectfully suggests the following abstract:

**A signaling apparatus including a substantially transparent panel, a light emitting element attached to a surface of the transparent panel, substantially transparent means for delivering power to the light emitting elements, and means for selectively**

controlling energization of the light emitting elements. The signaling apparatus being substantially transparent when the light emitting elements are not in an energized state. The light emitting elements might be LEDs, organic LEDs (OLEDs), electroluminescent displays, LCDs, or incandescent bulbs. The signaling apparatus is adapted to be mounted on a vehicle window for providing selectable patterns, variable rate flashing, changeable colors, textual or graphic messages, strobe lights, and other types of displays. Cooling channels or a cooling plenum may be provided to allow high power (e.g., high intensity) operation.

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “110” has been used to designate both “*frame region*” (page 9, line 21) and “*edge*” (page 9, line 23). In addition, note reference character “108” has been used to designate both “*light emitting elements*” (page 8, line 23) and “*electrical connections*” (page 10, line 6).

The applicant is advised that the reference characters must be properly applied, with no single reference character being used for two different parts or for a given part and a modification of such part. See MPEP §608.01(g).

4. Applicant is further advised that this action only exemplifies the objections to the drawings, applicant's cooperation is requested in correcting all the occurrences of the cited, or any other errors of which applicant may become aware in the specification.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Specification***

5. The disclosure is objected to because of the following informalities: no brief description of figures **4a**, **4b**, and **4c** is provided, as required by 37 F.C.R. 1.74. Appropriate correction is required.

6. The disclosure is objected to because of the following informalities: line 10 in page 12 should read "cooling using ~~Pelletier~~ Peltier devices, not shown, or the like may be used."

### ***Claim Objections***

7. Claim 6 is objected to because of the following informalities: lines 5 and 6 should read: "emitting elements, said controller comprising at least one input devices ,such input device being: a selector panel, a keyboard, and or a"

Appropriate correction is required.

8. Claim 9 is objected to because of the following informalities: line 3 should read "e) an electrochromic device disposed on said first"

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 5-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 5 is indefinite as it is not clear if the claimed hinged support is necessarily part of the claimed invention, or merely one of the alternatives recited by the Markush limitation of previous claims 4.

The applicant is advised that, in comparing the claimed invention with the Prior Art, the Examiner assumed Claim 5 as further defining the alternatively recited hinged support (Claim 4, lines 4 and 5), not as such hinged support being an actual element of the claimed invention.

11. Claim 6 is indefinite as it is not clear if the claimed invention includes one light emitting element (as recited in Claim 1), or a plurality of such elements (as suggested by the limitation "each of said light emitting elements).

The applicant is advised that, in comparing the claimed invention with the Prior Art, the Examiner assumed that the claimed invention includes a plurality of light emitting elements.

12. Claim 7 recites the limitation "*said selectively energized step*" in line 2. There is insufficient antecedent basis for this limitation in the claim.

13. Claim 8 is rejected for its dependency on rejected claims 6 and 7.



***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by BIFERNO (U.S. Pat. 4,568,928).

BIFERNO discloses a signaling apparatus having:

- **a first substantially transparent panel (as recited in Claim 1), Figure 3, reference number 56;**
- **the first panel having a front and a rear surface (as recited in Claim 1), as seen in Figure 3;**
- **the front and rear surfaces being substantially parallel to one another (as recited in Claim 1), as seen in Figure 3;**
- **the front surface being adapted for mounting to a vehicle window (as recited in Claim 1);**
- **a plurality of light-emitting elements (as recited in Claim 1), Figure 3, reference number 52;**
- **the light emitting elements (LEE) being affixed to the rear surface (as recited in Claim 1), as seen in Figure 3;**
- **the LEE being adapted to generate and project light away from the front surface (as recited in Claim 1), as evidenced by Figure 3;**

- **substantially transparent means for delivering power to the LEE (as recited in Claim 1), Figure 3, reference numbers 44 and 54;**
- **the means for delivering power being disposed on at least one of the front and rear surfaces (as recited in Claim 1), Figure 3, reference number 54;**
- **means for controlling (as recited in Claim 1), as evidenced by column 2, lines 39-63;**
- **the means for controlling being adapted to selectively control energization of the LEE (as recited in Claim 1), as evidenced by column 2, lines 39-62;**
- **visibility through the first panel being substantially unoccluded when said LEE is not in an energized state (as recited in Claim 1), column 3, lines 33-37;**
- **the LEE including at least one selected from the group consisting of LED, organic LED (OLED), electroluminescent device, incandescent bulb, halogen bulb, and fluorescent device (as recited in Claim 2), column 3, lines 17-19;**
- **means for mounting the apparatus to an object (as recited in Claim 3), as evidenced by Figure 1;**
- **the means for mounting including at least one selected from the group consisting of double backed adhesive device, a fixed bracket, and a hinged support (as recited in Claim 4), as evidenced by Figure 1;**

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- **a controller (as recited in Claim 6), as evidenced by column 2, lines 39-62;**
- **the controller being operatively connected selectively energize the LEE (as recited in Claim 6), as evidenced by column 2, lines 39-62;**
- **the controller including at least one of the input devices selected from the group consisting of a selector panel, a keyboard, and a receiver adapted to receive remotely generated control commands (as recited in Claim 6), as evidenced by column 2, lines 39-62;**
- **the controller performing at least one function selected from the group consisting of turning the LEE ON and OFF, controlling the intensity of the LEE, generating a pattern by energizing a predetermined number of LEE, controlling the color of the LEE, animating a pattern of LEE, providing a textual message, scrolling a textual message, and blinking the LEE at a predetermined rate and duration (as recited in Claim 7), as evidenced by column 2, lines 39-62;**
- **an electrochromic device (as recited in Claim 9), Figure 1, reference number 20; and**
- **the electrochromic device being disposed on the first panel (as recited in Claim 9), as evidenced by Figure 1.**

15. Regarding the front surface being adapted for mounting to a vehicle window (as recited in Claim 1), the applicant is advised that it has been held by the courts that the recitation that an element is adapted to perform a function or serve in a given

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application is not a positive limitation, but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. In this case, the patented signaling apparatus of BIFERNO was considered as capable of performing as claimed.

16. Regarding the hinged support including an electro-mechanical actuator operatively to move the apparatus about the hinge (as recited in Claim 5), The applicant is advised that such limitations were considered as directed to one of the alternatively recited means for mounting of Claim 4. See previous Section 10.

***Allowable Subject Matter***

17. Claim 8 is would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

18. Claims 10-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

19. The following is a statement of reasons for the indication of allowable subject matter:

Applicant teaches a signaling apparatus having first and second substantially transparent panels, a plurality of light emitting elements (LEE) attached to a surface of

the first panel, substantially transparent means for delivering power to the LEE, and means for selectively controlling energization of the light emitting elements. The first and second transparent panels define a plenum adapted for containing cooling air to cool the LEE. The signaling apparatus being substantially transparent when the LEE are not in an energized state, and includes means for remotely activating the LEE.

20. No prior art was found teaching individually, or suggesting in combination, all of the features of the applicants' invention, specifically an illuminated signaling apparatus being substantially transparent when not the light emitting elements are not energized and having a plenum adapted for cooling the light emitting elements with air, or means for remote activation, in combination with the other recited structural limitations of the claimed invention.

#### ***Relevant Prior Art***

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Pisciotta** (U.S. Pat. 3,004,359), **Williams** (U.S. Pat. 4,258,492) and **Murphy** (U.S. Pat. 4,645,970) disclose different types of signaling structures for vehicle windows.

**Meyer et al.** (U.S. Pat. 5,336,965) and **Alexander et al.** (U.S. Pat. App. 2005/0157513) disclose vehicle windows having electroluminescent illumination means integrally formed with the window panel.

**Conclusion**


22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached on (571) 272-2378. The facsimile machine number for the Art Group is (703) 872-9306.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications maybe obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.

Inr

September 29, 2005

  
THOMAS M. SEMBER  
PRIMARY EXAMINER